REMARKS

Claims 1, 3, 5-11, 13, 15-19, 21-22, 24, 26-32, 34, and 36 are presently pending in this application.

In the January 24, 2008 non-final Office Action, all of the pending claims were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 1, 3, 7-11, 13, 17-19, 22, 24, 28-32, 34, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0116240 to Hsuan ("Hsuan") in view of U.S. Patent No. 5,315,508 to Bain et al. ("Bain"); and

(B) Claims 5, 6, 13, 15, 16, 21, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsuan and Bain, and further in view of U.S. Patent No. 6,463,345 to Peachey-Kountz et al. ("Peachey-Kountz").

A. Response to Cited Art Rejections

Claims 1, 3, and 5-10 recite:

when the quantity of units of an item of an existing order has changed,

adding records representing increased units of the item to the unit order database, wherein each record includes the order number and the order item identifier of the corresponding order in the existing order database, and

setting records of the unit order database representing decreased units of the item to canceled.

Claims 11, 13, 15-19, and 21 recite "when the quantity of units of an item of an existing order has changed, means for adding records representing increased units of the item to the unit order database and means for setting records of the unit order database representing decreased units of the item to canceled." Claims 22, 24, 26-32, 34, and 36 recite "when the quantity of units of an item of an existing order has changed, adding records representing increased units of the item to the unit order database and setting records of the unit order database representing decreased units of the item to canceled." The Examiner has failed to cite a reference that corresponds to these recited features. It is the Examiner's position that these are:

conditional limitations of the method claim, and if the quantity of units of an item are never changed, then the method steps do not have to be performed in order for

> the claim limitations to be met. Hsuan does not disclose the quantity of units to be changed, therefore does not need to satisfy the conditional limitation, and anticipates the claim when the quantity of units does not change.

(Office Action, Jan. 24, 2008, p. 3.)

Applicant respectfully disagrees. Applicant is unaware of any authority that allows the Examiner to disregard a claim element. To the contrary, the United States Supreme Court has held that "[e]ach element contained a patent claim is deemed material to defining the scope of the patented invention." *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.,* 50 U.S. 17, 29 (1997). The Federal Circuit has held that this "all elements" rule applies to method and process claims, in addition to other claim forms. *Canton Bio-Medical, Inc. v. Integrated Liner Technologies, Inc.*, 216 F.3d 1367, 1370 (Fed. Cir. 2000). Applicant respectfully submits that, if the rejections under 35 U.S.C. § 103(a) are to be maintained, the Examiner must identify a reference that corresponds to each of applicant's claim elements.

Moreover, the "when" language recited by applicant's claims is not a "conditional limitation" as asserted by the Examiner. To the contrary, the term "when" is interpreted by courts to be mandatory, rather than conditional. The U.S. Court of Appeals for the Federal Circuit has held that "when" means "at the time of" rather than "upon condition." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1252 (Fed. Cir. 1998); *see also Thomson Consumer Electronics, Inc. v. Innovatron, S.A.*, 43 F.Supp.2d 26, 36 (D.D.C. 1999) ("The most common use of the term 'when' is to indicate a point in time. For example, of the six definitions set forth in one respectable dictionary, the first five have a temporal meaning; only the sixth supports [a] conditional reading."). In addition, the U.S. District Court for the Eastern District of New York has held that "when" is not equivalent to "if." In analyzing applicants' claims, the district court stated, "the plain language of the claim says 'when,' not 'if.' If the patent applicants had wanted the language to be hypothetical, they would have drafted it in that manner. The ordinary meaning of 'when' in [the claim language] is that at some point, [it] *will* [occur], not that it *may* [occur]." *Angelo Mongiello's Children, LLC v. Pizza Hut, Inc.*, 70 F.Supp.2d 196, 203 (E.D.N.Y. 1999).

For at least these reasons, applicant submits that the Examiner must identify a reference that corresponds to each of applicant's claim elements if the rejections under 35 U.S.C. § 103(a) are to be maintained.

B. Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the applied art. The applicants accordingly request reconsideration of the application and a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact the undersigned at (206) 359-8548.

Respectfully submitted,
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